

REMARKS

Applicant once more appreciates the indication in the Office Action dated 23 February 2010 (the "Office Action") that claim 11 is directed to allowable subject matter. However, Applicant submits that the present rejections of claims 1-9 are also improper, for at least two reasons. First, the Office Action makes no finding with regards to whether the cited teachings in Asthana (US 2009/0106380) are also present in provisional application 60/298,983. Second, Asthana does not disclose several features of the claimed invention for at least the reason that Asthana is not directed to a telecommunications network having first subscribers with autonomous type terminals and second subscribers with network type terminals. Instead, Asthana discloses techniques for re-directing e-mail from a user's fixed computer, resident on a LAN, to the same user's mobile computer, resident on a wireless network.

The Office Action does not establish that the teachings of Asthana are prior art.

The Court of Appeals for the Federal Circuit is currently considering the question of whether a reference claiming priority to a provisional application can be applied under 35 U.S.C. § 102(e) as of the filing date of the provisional application. (*In re Giacomini*, CAFC Docket 2009-1400, Ser. No. 09/725,737.) The Applicant in the present case takes the same position as the appellant in that proceeding – namely, that Section 102(e) does not shift the effective reference date for a patent or patent application to the filing date of a provisional application to which the reference claims priority. Thus, the effective filing date for Asthana is, at best, 18 June 2002, which is later than the priority date of the present application.

Nonetheless, even if Asthana is entitled to the effective filing date of provisional application 60/298,983 for some of Asthana's teachings, the present rejections are still improper, as the Office Action does not establish that the teachings of Asthana that are relied upon in the present action can be found in the provisional application. To maintain a rejection

under 35 U.S.C. § 102, the Office bears the burden of establishing that all of the elements of the claimed invention are found in a single prior art reference. Here, the Office Action has made no findings that any of the teachings relied upon are actually found in the provisional application.^{*} Without such findings, the present rejections fail to establish a *prima facie* case of anticipation, and should be withdrawn.

Asthana does not disclose the invention of claims 1 and 9.

1. Asthana does not disclose "a first telecommunications network having first subscribers with autonomous type terminals and second subscribers with network type terminals." According to the Office Action, this feature of claim 1 is disclosed by Fig. 2, which illustrates a mobile computer 24 and a desktop system 26. The Office Action equates Asthana's mobile computer 24 to the "autonomous type terminals" of the claim, and equates Asthana's desktop system 26 to the "network type terminals" of the claim. The Office Action is incorrect.

As an initial matter, there is absolutely no support in Asthana for the notion that Asthana's desktop systems "rely on functionality in the network to provide for retrieval of data object, as required by the claim of "network type terminals." This requirement of the claim can be contrasted with a separate requirement for "autonomous type terminals," namely that autonomous type terminals "comprise functionality for client-based retrieval of data objects." There is nothing in Asthana to suggest that Asthana's desktop system, which is apparently nothing more than an Internet-enabled personal computer, is any less capable of retrieving data objects itself than Asthana's mobile computers. Indeed, one would normally expect a full-

^{*} Because Provisional Application Ser. No. 60/298,983 is not available via Public PAIR, the undersigned is unable to determine for himself how much of Asthana's teachings, if any, are present in the provisional application. Should the examiner maintain the present rejections in a subsequent action, the Applicant would appreciate the examiner's inclusion of a copy of the provisional application.

featured personal computer to be more capable, not less. In any event, the distinctions in claim 1 between network-type and autonomous-type terminals are simply not applicable to the devices in Asthana. The present rejections should thus be withdrawn for at least this reason.

Second, the Office Action fails to address the fact that the claim is directed to a network having two different groups of subscribers, i.e., first subscribers and second subscribers. The first subscribers have autonomous type terminals (with the client-based capabilities discussed above), while the second subscribers have network type terminals (relying on the network for data object retrieval). In stark contrast, Asthana describes a system in which data is redirected from a user's desktop system to the same user's mobile computer. Given this proper understanding of the claim and of the teachings of Asthana, it is clear that Asthana's techniques do not remotely resemble the claimed invention, as Asthana is not distinguishing between subscribers having different types of equipment, and is not selectively providing services to one group of subscribers based on that distinction. The present rejections should thus be withdrawn for at least this additional reason.

Finally, the desktop systems identified by the Office Action as the "network type terminals" are not actually part of a telecommunications network at all. Instead, these desktop systems are isolated from any telecommunications network by a local area network. This network configuration is shown throughout Asthana, including at Figs. 1&3 (desktop computer 10 resides on LAN 14), Fig. 2 (desktop system 26 resides on LAN 14), and Fig. 6 (desktop system 214 is coupled to Internet via a host system 202 and a firewall). Thus, even assuming for the sake of argument that Asthana's desktop systems otherwise qualify as "network type terminals," Asthana does not disclose a "telecommunications network having ... autonomous type terminals and ... network type terminals." The present rejections should thus be withdrawn for at least this additional reason.

2. Asthana does not disclose "associating each of the first and second subscribers with the corresponding type of terminal." According to the Office Action, Asthana discloses this feature at paragraphs [0071]-[0073], where Asthana allegedly shows that "redirect server 12 associates with users of mobile computer 24 and user of desktop system 26 or 28." The Office Action is incorrect. Clearly, server 11 (which includes redirector software 12) is aware of an association between a given user's desktop system 26 and the same user's mobile computer 24. However, the claim is directed to an associating between each of several subscribers and the type of equipment each subscriber has. With this association, the rest of the claimed process is able to distinguish between first subscribers, associated with a first type of terminal (network type), and second subscribers, associated with a different type (autonomous type). This distinction is not present in Asthana, and is not possible in Asthana's system at least because Asthana's system does not associate each subscriber with one of (at least) two different types of terminals. The present rejections should be withdrawn for at least this reason.

3. Asthana does not disclose "selectively providing data object retrieval only to subscribers associated with network type terminals." According to the Office Action, this feature of claim 1 is disclosed by Asthana's redirection of a message from a desktop system 26 to a mobile computer 24. The Office Action is incorrect. Asthana describes a technique in which a redirector system chooses to send a particular message to a user's mobile computer, instead of to the same user's desktop system. In contrast, claim 1 is directed to a process in which a particular service (data object retrieval) is provided only to a particular group of subscribers, i.e., subscribers associated with network type terminals. Because this service is provided only to those subscribers (the "second subscribers" of the claim), the service is implicitly not provided to other subscribers, such as the subscribers associated with autonomous type terminals (the "first subscribers" of the claim). At best, then, Asthana discloses selectively delivering a message to one of two devices associated with a single user. Asthana does not, however, disclose the

selective providing of the data object retrieval only to a particular group of subscribers. The present rejections should be withdrawn for at least this reason.

4. The rejection of claim 9 is improper for the same reasons. Independent claim 9 is directed to a filtering server of a communication network, and is rejected for the same reasons as claim 1. For substantially the same reasons given above, this rejection is improper, and should be withdrawn.

Asthana does not disclose the features of dependent claims 2-8.

The Office Action's findings with regards to the dependent claims are in error. Several of these errors are based on the same misunderstandings of the invention and Asthana that are discussed above. In several cases, however, the Office Action makes additional erroneous findings with regards to the features of the dependent claims.

For instance, the Office Action incorrectly alleges that Asthana discloses "determining whether a subscriber involved in a first communication event belongs to a second network" and then selectively deferring data object retrieval to the second network based on that determination, as recited in claim 3. Asthana shows no such determining step, and does not teach a system that "selectively let[s] the second network provide data object retrieval to the subscriber." The rejection of claim 3 should be withdrawn for at least this additional reason.

Claim 4 also includes the step of determining whether a subscriber belongs to a second network, as well as a step of "selectively providing data object retrieval to the subscriber based on whether the second network provides data object retrieval for network type terminals." Again, the Office Action incorrectly finds that this is disclosed in Asthana. Nothing in Asthana remotely resembles the features of claim 4.

Claims 5 and 6 depend from claim 4, and are directed to restricting the types of data objects that provided, based on the determination in claim 4 that a subscriber belongs to a

second network. No such process is disclosed or suggested in Asthana. Rather, Asthana suggests only that a redirector might not redirect certain files, if it is determined that the targeted device cannot process those attachments. This selective delivery of attachments in Asthana is not related to a device's belonging to a particular network.

The rejection of claim 7 is accompanied only by a citation to Asthana's paragraph [0018], with no explanation. Claim 7 includes three distinct operations, none of which are present in the cited paragraph. This rejection should be withdrawn, as it completely lacks support.

The rejection of dependent claim 8 is supported by a citation to paragraph [0006] of Asthana. The applicant notes that Asthana's paragraph [0006] is describing a prior art system, which Asthana presents as an alternative to the system described in more detail in the remainder of Asthana. The features of Asthana's paragraph [0006] are not shown in combination with the features of Asthana's preferred system. Thus, the rejection of claim 8 is improper, as the combination of features in claims 1 and 8 are not disclosed in combination.

Conclusion

For the reasons given above, the rejections of claims 1-9 are improper and should be withdrawn. Allowance of the claims is thus respectfully requested.

Respectfully submitted,

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